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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|--------------------------|-----------------------------|------------------|
| 10/536,729 | 05/27/2005 | Michael Barry Gravestock | 100859-1P US | 4310 |
| 44992 7590 03/27/2007 ASTRAZENECA R&D BOSTON 35 GATEHOUSE DRIVE WALTHAM, MA 02451-1215 | | | EXAMINER CHU, YONG LIANG | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1626 | |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 03/27/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/536,729

Applicant(s)

GRAVESTOCK ET AL.

Examiner

Yong Chu

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-9,11-13,15 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) 15 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-9,11-13,18 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1, 5-9, 11-13, 15, and 18-23 are pending in this application. Claims 15 and 19 are withdrawn as non-elected invention. Therefore, claims 1, 5-9, 11-13, 18 and 20-23 are examined on the merits.

Response to Amendment

The Amendment by Applicants' representative John X. Haberman dated on 23 January 2007 has been entered.

Response to Arguments

Argument over rejection of claims under 35 U.S.C. §103(a)

The rejection over rejection of claims 1, 5-9, 11-13, 18, and 20-23 *under 35 U.S.C. §103(a)* have been fully considered but found not persuasive. Applicant has argued in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as AstraZeneca at the time this invention was made, or was subject to a joint research agreement at the time this invention was made. However, reference WO 03/022824 (hereinafter, "the '824 Publication") additionally qualifies as prior art under another subsection of 35 U.S.C. 102(a), and therefore, is not disqualified as prior art under 35 U.S.C. 103(c). The publication date of "the '824 Publication" is 03/20/2003, which is prior to the effective filing date of current application (11/24/2003).

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

Art Unit: 1626

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Applicant has attempted to disqualify reference the '824 Publication under 35 U.S.C. 103(c) by showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as AstraZeneca at the time this invention was made. However, applicant has failed to provide a statement that the application and the reference were owned by, or subject to an obligation of assignment to, the same person at the time the invention was made in a conspicuous manner, and therefore, is not disqualified as prior art under 35 U.S.C. 103(a). Applicant must file the required evidence in order to properly disqualify the reference under 35 U.S.C. 103(c). See MPEP § 706.02(I).

In addition, applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the inventor of this application, and is therefore, not the invention "by another," or by antedating the applied art under 37 CFR 1.131.

Therefore, the rejection over rejection of claims 1, 5-9, 11-13, 18, and 20-23 under 35 U.S.C. § 103(a) is maintained.

Argument over rejection under the obviousness-type double patenting

Art Unit: 1626

Applicants have not made any argument on the rejection. According to MPEP804§(I)(B)(1), If both applications are filed on the same day, the examiner should determine which application claims the base invention and which application claims the improvement (added limitations). The ODP rejection in the base application can be withdrawn without a terminal disclaimer, while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer. For the instant case, "the '824 Publication" is a base invention, and the current application is the improvement (added limitations) application. Therefore, TD should be filed in the current application to overcome the rejection. Therefore, the rejection over claims 1, 5-9, 11-13, 18, and 20-23 *under 35 U.S.C. §103(a)* is maintained.

Conclusion

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1626

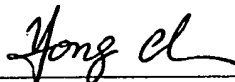
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.

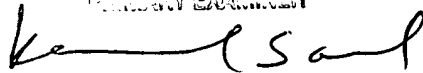
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M^cKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Patent Examiner
Art Unit 1626

JOSEPH K. M^cKANE, Ph.D.
SUPERVISORY EXAMINER



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